

Remarks

Claims 1-78 are pending in the present application. Claims 7, 9-13, 20, 22-26, 36, and 38-78 are withdrawn, and claims 1-6, 8, 14-19, 21, 27-35, and 37 have been elected for prosecution and are presently at issue.

Applicants have rewritten claim 28 in independent form to secure allowance of claims 28-33.

Applicants respectfully traverse: the rejection of claims 1-6, and 8 as anticipated by Tomasek et al. U.S. Patent No. 2,615,597; the rejection of claims 14-19, and 21 as anticipated by GB 1,445,029 (hereinafter "GB '029"); and the rejection of claims 27, 34, 35, and 37 as obvious over GB '029 in view of Gatland (not Lawrence) U.S. Patent No. 3,549,055 (hereinafter "Gatland").

Claim 1, and claims 2-6 and 8 dependent thereon, as amended, recite in part "a hollow stem in fluid communication with the valve and having a tapered outside surface extending to a reduced diameter tip terminating in an exterior end that has at least one side opening therethrough wherein the valve is actuable to dispense product through the side opening."

Tomasek et al. fails to disclose or suggest a tapered outside surface extending to a reduced diameter tip terminating in an exterior end that has at least one side opening as specified by these claims.

In fact, Tomasek et al. discloses a valve stem having slots 32 provide to improve the foaming action of whipped cream as the whipped cream exits the valve stem. The valve stem appears to have a substantially constant diameter and there is no illustration of a tapered outside surface. In the present application, a tapered outside surface and reduced diameter tip allow the claimed valve stem to be usable with a dispensing apparatus of a type such as that shown in FIGS. 25-26, which makes these claimed features of the hollow stem highly advantageous.

Claims 14, and claims 15-19 and 21 directly or indirectly dependent thereon, now recite in part "wherein the stem is adapted for engagement with the apparatus to permit dispensing of product through the at least one side opening into a chamber of the dispensing apparatus."

GB '029 fails to disclose or suggest at least one side opening that permits product flow into a chamber of dispensing apparatus as specified by these claims.

GB '029 discloses a spray cap having a discharge orifice wherein the cap is rotated to align the discharge orifice with one of three differently sized metering slots 15, 15a, 15b to selectively control the amount of flow through the discharge orifice. However, there is no disclosure or suggestion of dispensing a product through a side opening of a hollow stem into a chamber of dispensing apparatus as claimed. In fact, it is contended that the disclosed discharge orifice would ordinarily be used for flow to ambient surroundings rather than flow into a chamber of dispensing apparatus as claimed.

Claim 27, and claims 34, 35, and 37 dependent directly or indirectly thereon, as amended, specify in part "to permit dispensing of product through the at least one side opening into a chamber of the dispensing apparatus."

There is no suggestion in GB '029 or Gatland, whether taken individually or in combination, of apparatus that permits dispensing of product through a side opening into a chamber of a dispensing apparatus as claimed.

GB '029 teaches apparatus for selectively changing flow rates, and Gatland teaches a squeezable housing for an aerosol container where squeezing action expended by a user causes actuation of a valve stem and consequent dispensing from the housing. Because squeezable housings, flow rate control, and apparatuses provided therefor are entirely different than the claimed subject matter, it would not be obvious to combine the teachings of GB '029 and Gatland to arrive at apparatus that permits supply of a chamber of dispensing apparatus through a side opening as specified in claims 27, 34, 35, and 37.

In conclusion, because the prior art fails to disclose or suggest all of the features recited by the claims at issue, it follows that the claims are not anticipated thereby. In addition, the prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. *See In re Sernaker*, 217, U.S.P.Q. 1 (Fed. Cir. 1983); *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Because the cited references (individually or collectively) do not teach or suggest that it would have been desirable or even possible to provide a side opening to permit

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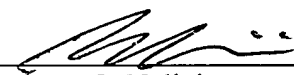
supplying a chamber of dispensing apparatus as specified by the claims at issue, it follows that the claims are not obvious thereover.

Also submitted herewith is a Petition to Correct Inventorship along with the requisite fee therefor.

Reconsideration and allowance of the foregoing claims are respectfully requested.

Respectfully submitted,

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